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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,489	06/26/2007	Giacomo Stefano Roba	09877.0346	5293

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EXAMINER	
MOONEY, MICHAEL P	

ART UNIT	PAPER NUMBER
2883	

MAIL DATE	DELIVERY MODE
07/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,489	ROBA ET AL.	
	Examiner	Art Unit	
	MICHAEL P. MOONEY	2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *53-112* is/are pending in the application.

4a) Of the above claim(s) *94-105* is/are withdrawn from consideration.

5)☒ Claim(s) *68-93* is/are allowed.

6)☒ Claim(s) *53-64 and 106-112* is/are rejected.

7)☒ Claim(s) *65-67* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/22/09, 4/6/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3/16/09 have been fully considered but they are not fully persuasive. The Office at this juncture withdraws part of the restriction requirement except for the 1st part that restricts between Groups I and II. As can be seen in the rejection below, claims 53-64 have been rejected, yet there is still a **serious** search burden with respect to non-elected chemical composition claims 94-105. E.g., the reference applied in the rejection below does not appear to have the same chemical composition as claimed in claims 94-105. These claims 94-105 contain no optical fiber and require evaluation in a completely different art, e.g. a chemical art, in order to properly determine the patentability of the compound. No rejoinder issue exists for claims 94-105.

All of Applicants' pertinent arguments have been addressed.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 53-64, 106-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hale (5822489).

Hale teaches an optical fiber comprising: a glass portion (e.g., col. 1 lines 10-25); and at least one protective coating layer disposed to surround said glass portion (e.g., col. 3 lines 1-26; col. 1 lines 10-25); said protective coating layer having a modulus of elasticity value (e.g., col. 3 lines 1-26; col. 1 lines 10-25).

Although Hale does not expressly state "between -40.degree. C. and +60.degree. C. between 5 MPa and 600 MPa" the claimed range is rendered as obvious under the principle of obviousness of ranges discussed in the MPEP as follows:

2144.05 Obviousness of Ranges

I. OVERLAP OF RANGES

In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of "50 to 100 Angstroms" considered prima facie obvious in view of prior art reference teaching that "for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms]." The court stated that "by stating that suitable protection' is provided if the protective layer is about' 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within applicant's] claimed range."). Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that on skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1%

iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.).

Since Hale teaches values within the claims stated ranges at, e.g., col. 3 lines 1-26, col. 1 lines 10-25, and col. 4 lines 30-45, the above principle of obviousness of ranges applies to render the ranges of claim 53 as obvious.

Thus claim 53 is rejected.

Similarly, the aforementioned principle of obviousness of ranges also applies for claims 54-58, 61-64 (e.g., col. 3 lines 1-26, col. 1 lines 10-25, and col. 4 lines 30-45). Thus claims 54-58, 61-64 are rejected.

Each and every element of each of claims 59, 60 is rendered as obvious by the reasons and references given above and/or conventionally known art-established principles. Thus claims 59, 60 are rejected.

By the reasons and references given above and/or conventionally known art-established principles each and every element of each of method claims 106-112 is rendered as obvious under Hale. If Applicant disagrees with this obviousness holding regarding said method claims, then Applicant should submit evidence showing this obviousness holding is errant. Examiner will then consider restricting. Thus claims 106-112 are rejected.

Allowable Subject Matter

Claims 68-93 are allowed.

Claims 65-67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL P. MOONEY whose telephone number is 571-272-2422. The examiner can normally be reached during weekdays, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael P. Mooney/
Primary Examiner, Art Unit 2883